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REMARKS

The Examiner has required restriction under 35 USC 121 to one of the following inventions:

- I. Claims 1-15, drawn to a gypsum board with silane coated glass fibers, classified in class 428, subclass 296.1+;
- II. Claims 16-30, drawn to a gypsum board with silane in the matrix, classified in class 428, subclass 294.7; and
- III. Claims 31-32, drawn to a process of making gypsum board, classified in class 156, subclass 42+.

In response to the restriction requirement, applicants hereby elect, with traverse, the invention of Group II, claims 16-30 for further prosecution on the merits.

Reconsideration of this restriction requirement is respectfully requested. The Examiner has stated that the inventions, as grouped, are separate and distinct because inventions of Group I, Group II, and Group III are related as process of making and product made, and the product, as claimed, can be made by another materially different method.

Applicant acknowledges that process claims 31 and 32 indeed recite processes by which the gypsum board of claims 1-29 can be made. On the other hand, both Groups I and II comprise product claims directed to gypsum board. The basis set forth for the restriction ("the product can be made by another method...") at best distinguishes Group III from Groups I and II; but does not support restriction between Groups I and II which, as acknowledged by the Examiner, contain claims drawn to product embodiments. While the respective claims of Groups I and II have been classified in separate

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subclasses within the same class 428, the Examiner has provided no further justification for the restriction requirement between Groups I and II. In particular, the Examiner has not shown that the alleged inventions of Groups I and II are patentably distinct or operate in a materially different way, as required for restriction under the criteria delineated by MPEP 806.05(j).

It is well established that applicants should be allowed reasonable latitude in claiming their invention, provided they do not unduly multiply the claims, which is not the case here. Ex parte Seiback 151 U.S.P.Q. 62. It is submitted that the fields of search involved in examining the present claims as grouped would, as a practical matter, be essentially co-extensive and the best interests of the public would be served by having all of the claimed subject matter in the same application. Specifically with reference to Groups I and II, respective base claims 1 and 16 of these Groups both recite a gypsum board comprising a gypsum matrix, first and second facers sheets on the top and bottom of the gypsum matrix, and silane-coated glass fibers within the gypsum matrix. Applicants submit that pertinent searching with respect to the claims of Groups I and II would involve virtually the same art, mooted any ground for restriction based on an allegedly different classification of the respective claims of these groups.

Accordingly, reconsideration of the restriction requirement with respect to Groups I and II is respectfully requested.

It is further submitted that the Examiner's contention that the product claimed in either Group I or Group II could be made by another materially different method is merely conclusory. The Applicant respectfully maintains that the Examiner has purely recited, in very general terms, an enumeration of steps known in the art for gypsum board production, without demonstrating a plausible

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alternative method for making the product delineated by claims 1-29. It is thus submitted that the restriction requirement falls short of the standard imposed under *In re Lee*, 277 F.3d 1338, 1344-45, 61 USPQ2d 1430, 1435 (Fed. Cir. 2002) (finding that reliance on "common knowledge and common sense" did not fulfill the PTO's obligation to cite references to support its conclusions, as the PTO must document its reasoning on the record to allow accountability and effective appellate review.)

Accordingly, reconsideration of the restriction requirement distinguishing Group III from either Group I or Group II is respectfully requested.

The Examiner has further required election of a single species from among claims 21, 22, 23, 24, 25, and 26, if the invention of Group II is elected. It is further indicated that election of one of claims 27 and 28 is required if claim 26 is elected.

In response to the election of species requirement, applicant hereby provisionally elects, with traverse, the species of claims 26 and 27 for further prosecution on the merits.

Although the instant restriction requirement does not identify any one or more claims as being generic to the alleged species or indicate that there appears to be no allowable generic claim, it is submitted that: (i) claim 16 is generic to each of claims 21-28; claim 21 is generic to claims 23; claim 22 is generic to claim 24; and claim 26 is generic to claims 27 and 28 dependent thereon. Applicant respectfully maintains that upon allowance of claim 16, all of claims 17-30 dependent thereon would be entitled to allowance; upon allowance of claim 21, claim 23 would be entitled to allowance; upon allowance of claim 26, claims 27 and 28 dependent thereon would be entitled to allowance; and upon allowance of claim 22, claim 24 would be entitled to allowance.

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Applicant further submits that the species alleged by the Examiner are not all mutually exclusive, as required for a proper species restriction requirement. In particular, claims 21 and 23 call for a gypsum board and a silane-based sizing composition that includes a hydrophobic moiety, whereas in claims 22 and 24, the silane based sizing composition includes a hydrophilic moiety. As set forth in the specification, e.g. at page 11, lines 15-24, certain silicone polymer molecules have two distinct regions or "ends," of which one is hydrophobic and one is hydrophilic. A gypsum board employing glass fibers coated with a silane sizing composition having both a hydrophobic moiety at one end of the silane polymer molecule and a hydrophilic moiety at another end of the molecule would therefore read on both: (i) claims 21 or 23; and (ii) claims 22 or 24, precluding any finding that the alleged species of: (i) claims 21 or 23; and (ii) claims 22 and 24 are mutually exclusive, as required for the species election required by the Examiner in the June 16, 2006 Office Action.

Accordingly, reconsideration of the requirement for election of a single disclosed species from among the species claims 21, 22, 23, 24, 25, and 26 is respectfully requested.

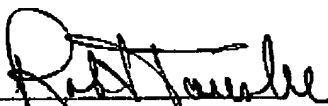
Applicant respectfully submits that the same considerations that govern the requirement for a species election among the alleged species of claims 21, 22, 23, 24, 25, and 26 are equally applicable to the requirement for election of a single disclosed species from among claims 6, 7, 8, 9, and 10 of Group I. In light of those considerations, it is respectfully submitted that the election requirement involving claims 6-10 of Group I should be withdrawn.

Accordingly, reconsideration of the requirement for election of a single disclosed species from among the species claims 6, 7, 8, 9, and 10 is respectfully requested.

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In view of the foregoing remarks, applicants submit that the present application is not properly subject to the restriction requirements set forth in the June 16, 2006 Office Action. It is further submitted that claims 1-32, as now presented, are in condition for allowance. Accordingly, reconsideration of the restriction requirement and allowance of original claims 1-32 are respectfully requested.

Respectfully submitted,
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